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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/640,558	08/13/2003	Paul D. Van Duyen	P00769-US-00 (15859.0053)	8350
31835	7590	04/28/2005	EXAMINER	
RUSSELL E. FOWLER, II ICE MILLER ONE AMERICAN SQUARE, BOX 82001 INDIANAPOLIS, IN 46282-0002			CHOI, JACOB Y	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/640,558

Applicant(s)

PETER DAVID GAMMACK ET AL.

Examiner

Jacob Y. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/13/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 8/13/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Note: missing foreign patent documents EP 0 661 495 A1 and P2001-118407A (JP)

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claims 1, 4, 9, 8, 9, 12, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 8, 20, 21 and 27 of copending Application No. 10/640,550. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Application No. 10/640,558 claim #	Application No. 10/640,550 claim #
1	1, 7 and 15, 21
4	8, 20
8	1, 7, 15, 21 and 27
9	1, 7 and 15, 21
12	8, 20
16	1, 7, 15, 21 and 27
17	1, 7, 15, 21 and 27

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsukawa (USPN 6,837,601) in view of Taniuchi et al. (USPN 6,160,029).

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Regarding claims, 1 and 9, Tatsukawa discloses a lamp assembly having a reflector (24) with a first reflecting surface (24a1) and a second reflective surface (24a2), a light source (22) and a movable shield (26; Figures 2-3, column 5, lines 38-52).

Tatsukawa discloses does not specifically disclose a non-reflective surface being disposed between thereof.

Taniuchi et al. discloses a non-reflective surface (horizontal portion) being disposed between reflecting surfaces (41, 42; Figures 3-4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the reflector structure of Tatsukawa with the non-reflective surface as taught by Taniuchi et al. for purpose of providing an advantageous way of aligning reflector structure to obtain a desired low/high beam.

Regarding claims 2 and 10, Tatsukawa in view of Taniuchi et al. discloses the claimed invention, explained above. In addition, Taniuchi et al. discloses the non-reflective surface is a matte surface.

Regarding claims 3 and 11, Tatsukawa in view of Taniuchi et al. discloses the claimed invention, explained above. In addition, Taniuchi et al. discloses the non-reflective surface is substantially parallel to the optical axis of the lamp assembly.

Regarding claims 4 and 12, Tatsukawa in view of Taniuchi et al. discloses the claimed invention, explained above. In addition, Tatsukawa discloses the light shield is substantially cylindrical.

Regarding claims 5 and 13, Tatsukawa in view of Taniuchi et al. discloses the claimed invention, explained above. In addition, Tatsukawa discloses the drive is comprised of a solenoid.

Regarding claims 6, 7, 14 and 15, Tatsukawa in view of Taniuchi et al. discloses the claimed invention, except additional surfaces on the reflector and third position for the shield.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the reflector with additional non-reflective surface disposed between the 2<sup>nd</sup> and 3<sup>rd</sup> reflective surface and third position for the shield operable between the surfaces, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 8 and 16, Tatsukawa in view of Taniuchi et al. discloses the claimed invention, explained above. In addition, Tatsukawa discloses wherein light reflected from the first reflective surface forms a low bema or high beam and light reflected from the second reflective surface forms a plurality of points of light positioned around the low beam or the high beam.

Regarding claim 17, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Tatsukawa in view of Taniuchi et al. discloses

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structural limitations of the claimed invention, explained above, therefore, mere claiming of use of particular structure (claim 17) is not entitled to weight in method claims.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 18-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Futami (US 2003/0174509).

Regarding claim 18, Futami discloses a light source (3), a first reflective surface (2) arranged and disposed to reflect light from the light source for a low beam or high beam [0086], a second reflective (15) surface arranged and disposed to reflect light from the light source and provide a beam pattern that forms a plurality of points of light positioned about the optical axis (Figures 3A, 3B and 8).

Regarding claim 19, Futami discloses the second reflective surface is a single integral reflective surface and a plurality of lens (9) are positioned in front of the single integral reflective surface to form a plurality of points of light.

Regarding claim 20, Futami discloses the plurality of lenses are positioned upon a ring shaped retainer (6).

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Regarding claim 21, Futami discloses a light source (3), a first reflective surface (2) arranged and disposed to reflect light from the light source for a low beam or high beam [0086], a second reflective surface (15) arranged and disposed to reflect light from the light source and provide a beam pattern that forms a ring shaped beam of light positioned around the optical axis (Figures 3A, 3B and 8).

Regarding claim 22, Futami discloses the ring shaped beam of light is 360 degrees in circumference.

Regarding claim 23, Futami discloses a ring shaped lens is positioned to receive light from the second reflective surface (9).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hu (USPN 6,641,295) – fog light device

Futami (USPN 6,578,997) – multi-ocular light

Hayakawa (USPN 6,607,295) – vehicle headlamp

Taniuchi et al. (USPN 6,575,609) – vehicle headlight

Oyama et al. (USPN 6,527,426) – vehicle lamp

Taniuchi et al. (USPN 6,454,448) – head lamp for vehicle

Hamm et al. (USPN 6,059,435) – headlight of a vehicle for high beam light and low beam light

Daumueller et al. (USPN 5,718,505) – headlight for vehicle



Kretschmer et al. (USPN 4,772,987) – headlight for antifog lamp for automotive vehicle


Suzuki (USPN 6,578,995) – vehicular headlamp and vehicle provided with same

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



**JOHN ANTHONY WARD**  
**PRIMARY EXAMINER**